

REMARKS

In the communication dated July 27, 2000, the Examiner noted that claim 21 submitted in the response filed August 31, 1998 for purposes of interference and corresponding exactly to claim 1 of U.S Patent No. 5,479,378 to Yamada et al. ("the Yamada et al. patent") was presented more than one year after the grant of the Yamada et al. patent. The Examiner required an explanation under 35 U.S.C. §1.607(6) of how the requirements of 35 U.S.C. §135(b) are met for claim 21. More specifically, the Examiner required an explanation of how claims 21 and 20 are drawn to the same patentable invention within the meaning of 37 C.F.R. §1.601(n). The Examiner further required a supplemental reissue declaration directed to the subject matter of claim 21 pursuant to 37 C.F.R. §1.175(b)(1).

Explanation of How the Requirements of 35 U.S.C. §135(b) Are Met

Claims 20 and 21 are drawn to the same patentable invention. Claim 20 was present in this reissue application prior to one year from the date on which the Yamada et al. patent was granted as set forth in the April 27, 1998 response.

Claims 20 and 21 require an analog watch for receiving and displaying a paging message and having a body

(claim 21) or a dial (claim 20), marks disposed on the body or dial representing paging messages, and a plurality of movable hands for displaying time. Claims 20 and 21 further require that when a paging message is received, one of the movable hands is moved to point to (claim 21) or indicate (claim 20) one of the marks to indicate the paging message. The only differences between claims 20 and 21 are shown by the following underlined language which is present in claim 20 but either omitted from, or more broadly worded in, claim 21:

- (a) a receiver for receiving paging messages;
- (b) a time indicating device having a dial, and a plurality of movable hands disposed over the dial for indicating time;
- (c) a memory for storing the paging messages received by the receiver;
- (d) a transducer for signalling the receipt of a paging message by the receiver; and
- (e) circuit means for receiving paging messages from the receiver and, in response to receiving one of the paging messages, for controlling movement of one of the hands of the time indicating device to stop indicating time and to indicate the mark representing the paging message.

With respect to the recitations in sub-paragraphs (a), (c) and (d), it is commonplace in the pager art to

provide pager systems with a receiver for receiving a paging message, a memory for storing the paging message, and a transducer for signalling the receipt of the paging message by the receiver and, therefore, each of these features is not a patentable distinction over claim 21. Stated otherwise, inclusion of a receiver, a memory and a transducer in claim 21 would not amount to a patentable difference.

With respect to the recitation in sub-paragraph (b), claim 21 broadly recites a "body" which corresponds to the dial in claim 20. Furthermore, it is notoriously commonplace in the analog timepiece art to provide a dial or body over which the movable hands are disposed for the purpose of displaying time. Thus, this feature is not a patentable distinction over claim 21.

With respect to the recitation in sub-paragraph (e), claim 21 broadly recites the step of moving one of the hands to point to one of the marks to indicate a paging message. It is commonplace in the analog timepiece art to provide circuitry for controlling movement of one or more of the hands for displaying time. Furthermore, claim 21 broadly recites "moving one of the hands" for displaying time "to point to one of the marks" and, therefore, requires the hand being moved to stop indicating time. Accordingly, the recitation in sub-paragraph (e) is not a patentable distinction over claim 21.

Applicant further submits herewith an unsigned fifth

supplemental reissue declaration directed to the subject matter of claim 21. The original fifth reissue declaration is in the process of being executed and will be transmitted to the Examiner shortly by supplemental response.

In view of the foregoing, applicant respectfully submits that the application is now in condition for allowance. Accordingly, applicant respectfully requests that an interference be declared with U.S Patent Nos. 5,329,501 and 5,479,378 as proposed by the Examiner in the July 30, 1998 Office Action.

Respectfully submitted,

ADAMS & WILKS
Attorneys for Applicant

By: 

Bruce L. Adams
Reg. No. 25,386

50 Broadway
31st Floor
New York, New York 10004
(212) 809-3700

MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner of Patents & Trademarks, Washington, D.C. 20231, on the date indicated below.


Bruce L. Adams

Attorney Name

-5-

Signature

August 28, 2000

Date